

REMARKS

In the Office Action¹ mailed March 21, 2007, claims 1 - 45 were rejected. With this Amendment and Response, Claims 1 - 7, 9 - 11, 14 - 16, 18 - 33, 35 - 45 are amended. Claims 1 - 45 remain pending in the application of which claims 1, 19, 33 and 45 are independent.

Specifications

The amendments to the Specifications correct three numbering errors. No new matter is introduced by the foregoing amendments.

Figures

The amendments to Figure 7 and 8 correct four numbering and labeling errors.

In Figure 7, the server that is in the content provider 540a is now labeled 102a. The Internet is now numbered 208. The license box in 540a is now numbered 130d. In Figure 8, the box 48 is relabeled to be WAN and the remote server is now numbered 50. No new matter is introduced by the foregoing amendments.

Claims

By this amendment, Applicant amends claims 1 - 7, 9 - 11, 14 - 16, 18 - 33, 35 - 45 to improve readability and to more appropriately define Applicant's invention.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

Support for the amendments can be found in Applicant's specification at, for example, page 10 on lines 16-18 and page 9, lines 21 - 22.

Rejection under 35 U.S.C. §101

In the Office Action, claims 19-32 were rejected under 35 U.S.C. §101 on the grounds that "a computer program product" recited in the preamble is not a concrete and tangible medium. Applicant respectfully traverses this rejection. However, to further prosecution, Applicant has amended claims 19-32 to recite "tangibly-embodied computer-readable medium."

Applicant respectfully requests the rejection under 35 U.S.C. §101 of claims 19-32 to be withdrawn.

Rejection under 35 U.S.C. §102(e)

In the Office Action, claims 1, 6-17, 19, 24-35 and 39-45 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Publication No. 2005/0021783, by Ishii (hereinafter, "*Ishii*"). To properly establish that a prior art reference anticipates a claimed invention under 102(e), each and every element of the claims in issue must be found, whether expressly described or under principles of inherency, in the single prior art reference.

Applicant respectfully traverses the rejection of claims 1, 6-17, 19, 24-35 and 39-45 and submits that *Ishii* does not teach or suggest each and every element of these claims. For example, *Ishii* does not teach or suggest at least "using the **content URL address** to identify the **licensing information address**", as recited in Claim 1

(emphasis added). The Office Action cites para. 0105 and 0108, stating that *Ishii* discloses “allowing the user to perform the license acquisition by clicking to the URL link information on the license server.”

Applicant agrees that *Ishii* para. 0105 describes performing license acquisition “by clicking on the URL link information on the license server including the license IDs inserted in HTML files of Web sites, e-mail, and the like.” However, nowhere in *Ishii* para. 0105, or elsewhere in *Ishii*, is there a suggestion that the **content URL address** is involved in performing license acquisition. For example, *Ishii* does not suggest or teach that the URL link information on the license server includes the content URL address, or that the content URL address is used to obtain the URL link information. As for the citation of *Ishii* para. 0108, therein is disclosed an accounting server responding to a request for license authorization by checking records of past payments by the user for past license acquisitions. If there is a record of non-payment, license authorization is not granted. Nowhere in *Ishii* para. 0108, or elsewhere in *Ishii*, is there a suggestion that the accounting server records are identified or checked using the **content URL address**. As such, the cited portions of *Ishii* does not teach or suggest “using the content URL address to identify the licensing information address,” as recited in claim 1.

Finally, *Ishii* does not teach or suggest **“comparing the content URL address with the licensing information** to confirm that the unit of digital content associated with the content URL address is licensed to be provided to the client system”, as recited in Claim 1 (emphasis added). As noted above, *Ishii* does not involve the content URL address in the process of determining whether a license is appropriate. Therefore, it does not suggest the recited feature.

For at least these reasons, claim 1 is allowable under 35 U.S.C. §102(e).

Although the other independent claims (19, 33, and 45) are different in scope from claim 1, they recite elements similar to claim 1. Therefore, they are allowable under 35 U.S.C. §102(e). See Office Action at 4. Additionally, claims 6-17, 24-32, 34, 35, and 39-44 are also allowable at least since they depend from one of claims 1, 19, and 33.

Since Applicant's claims are patentably distinct from *Ishii*, Applicant respectfully requests the rejection under 35 U.S.C. §102(e) of independent claims 1, 19, 33, 45 and claims 6-17, 24-32, 34, 35 and 39-44, which depend therefrom, to be withdrawn.

Rejection under 35 U.S.C. §103

Applicant respectfully traverses the rejection of claims 2-5, 18, 20-23 and 36-38 under 35 U.S.C. §103(a) as being obvious from over *Ishii* in view of US Patent Application Publication No. 2004/0181490, by Gordon et al. (hereinafter "*Gordon*").

To establish a *prima facie* case of obviousness, the prior art (separately or combined) must teach or suggest all the claim limitations. See M.P.E.P. §2142, 8th Ed. Rev. 5(August 2006). Moreover, "in formulating a rejection under 35 U.S.C. §103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed." USPTO Memorandum from Margaret A. Focarino, Deputy Commissioner for Patent Operations, May 3, 2007, page 2.

A *prima facie* case of obviousness has not been established because, among other things, *Ishii*, taken alone or in combination, fails to teach or suggest each or every element of claims 2-5, 18, 20-23 and 36-38.

Claims 2-5, 18, 20-23 and 36-38 depend from claim 1, 19 and 33, and thus include all the elements and limitations thereof. First, as to claim 2, *Ishii* does not teach, disclose or suggest the features recited in claim 1, upon which claim 2 depends, namely:

- “using the **content URL address** to identify the **licensing information address**” (emphasis added);
- “**comparing the content URL address with the licensing information** to confirm that the unit of digital content associated with the content URL address is licensed to be provided to the client system” (emphasis added).

These distinctions are described in detail above in connection with the rejection under 35 U.S.C. §102(e) of claim 1. *Gordon* does not make up for these deficiencies of *Ishii* where *Gordon* also does not teach, disclose or suggest these features. The system in *Gordon* checks if a content URL used by a subscriber has been used in the past to request the content file. See *Gordon* at para. 0031, lines 19-22. It reviews a stored list of URLs of the content files that had been requested in the past, and it compares the content URL with these previously requested URLs to determine whether the content URL matches one of the previously requested URLs. See *Gordon* at para. 0031, lines 12-14. The *Gordon* comparison does not:

- use the **content URL address** to identify the **licensing information address**;
- **compare a content URL address with licensing information** to confirm that a unit of digital content associated with the content URL address is licensed to be provided to the client system.

In addition, *Ishii* does not teach, disclose or suggest the feature recited in claim 2 of “comparing the URL pattern referenced in the licensing information with the content URL address.” The Office Action suggests the same conclusion. See Office Action at 8. However, *Gordon* does not make up for this deficiency of *Ishii*, because *Gordon* also does not teach, disclose or suggest, “comparing the URL pattern referenced in the licensing information with the content URL address,” as in Applicant’s claim 2. The Office Action cites *Gordon* at para. 0031 as so teaching. See Office Action at 8. As noted above, the system in *Gordon* checks a list of URLs of previously accessed files to see if the content URL used by the subscriber has been used in the past to request the content file. See *Gordon* at para. 0031, lines 19-22. It compares the previously accessed URLs with the content URL. See *Gordon* at para. 0031, lines 12-14. The URL comparison of *Gordon* at 0031 does not involve accessing or reviewing the URL pattern referenced in the licensing information, or comparing it with anything. Therefore, *Gordon* at para. 0031 and elsewhere does not disclose, “comparing the URL pattern referenced in the licensing information with the content URL address,” as in Applicant’s claim 1, and required by claim 2.

For at least these reasons, a *prima facie* case of obviousness with respect to claim 2 has not been proved. The rejection of claim 2 under 35 U.S.C. §103 as being obvious from *Ishii* in view of *Gordon* is thus improper and should be withdrawn.

Turning now to the rejection of Claim 3, *Ishii* does not teach, disclose or suggest “confirming that the license covers the content by determining that the URL pattern referenced in the licensing information corresponds to the content URL address,” as in Applicant’s claim 3. The Office Action suggested the same conclusion. See Office

Action at 8. *Gordon* does not make up for this deficiency of *Ishii*. In *Gordon*, when the user requests to download the content by clicking on the content URL address, the system searches in its memory for whether there has been a previous request with the same URL. See *Gordon* at para. 0029, lines 15-17. The system confirms that the content is licensed by comparing the content URL and the URL of the previously accessed content files that have been stored in memory. It does not suggest or teach using the licensing information nor the URL patterns referenced in the licensing information to confirm the license coverage of the content. Therefore, *Gordon* does not teach, disclose or suggest, "confirming that the license covers the content by determining that the URL pattern referenced in the licensing information corresponds to the content URL address," as in Applicant's claim 3.

For at least this reason, a *prima facie* case of obviousness with respect to claim 3 has not been proved. The rejection of claim 3 under 35 U.S.C. §103 as being obvious from *Ishii* in view of *Gordon* is thus improper and should be withdrawn.

For at least the reasons noted above with respect to claims 2 and 3, claims 4-5, 18, 20 - 23 and 36 - 38, which recite similar elements rejected under the same rationale, are allowable under 35 U.S.C. §103(a). See Office Action page at 9.

Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

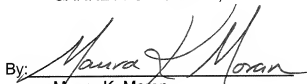
Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated:

Sep 20, 2007

By:

A handwritten signature in black ink, appearing to read "Maura K. Moran", written over a horizontal line.

Maura K. Moran
Reg. No. 31,859

Attachments: Two sheets of Replacement Drawings